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Girish G Parekh

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EXAMINER

JACOBSON, MICHELE LYNN

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Arguments***

1. Applicant's arguments filed 10/11/10 have been fully considered but they are not persuasive.
2. Applicant's amendments to independent claims 1 and 20 are sufficient to overcome the rejection of claims 1, 3-6, 9-15, 18-21, 26 and 27 under 35 USC 102(b) set forth in the final rejection mailed 8/17/10. The amendments to independent claims 1 and 20 incorporate the limitations of claim 16 which is now cancelled. Claims 1, 3-6, 9-15, 17-21 and 26-30 remain rejected under 35 USC 103(a) as set forth in the final rejection mailed 8/17/10 since this rejection addressed the limitations of claim 16 in combinations with independent claims 1 and 20.
3. Applicant asserts on page 7 of the remarks that the examiner's rejection of claims 16 and 17 in the rejection mailed 8/17/10 was "based on an obvious-to-try rationale". This is an inaccurate representation of the rejection set forth by the examiner. There was no statement asserting that it would have been "obvious-to-try" using an acrylate copolymer with pendent glycidyl groups. The examiner clearly set forth an explicit motivation found within the prior art that one of ordinary skill would have been motivated to use an acrylate copolymer with pendent glycidyl groups in order to improve the corrosion resistance of the polymer disclosed by Heyenk.
4. Nonetheless, applicant's assertion on page 8 of the remarks that because there exists a large number of references in the prior art one of ordinary skill would not be

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motivated to choose any of them is not found persuasive. According to applicant's logic, one of ordinary skill would perpetually be overwhelmed by the body of knowledge available in the prior art and therefore there no invention would ever be obvious. The Parekh reference is relied upon to provide the motivation and means to increase the corrosion resistance of a polyester meant for can coatings. It is clearly analogous art to the teachings of Heyenk and establishes that it was known in the art that the combination of polyester and an acrylate copolymer with pendent glycidyl groups provides increased corrosion resistance.

5. Applicant's assertion on page 8 that it is "pure speculation" that the addition of an acrylate copolymer with pendent glycidyl groups would improve the corrosion properties of Heyenk is not supported by any scientific reasoning or evidence. The examiner has provided a teaching in the prior art replete with evidence of the increased corrosion resistance of polyesters comprising an acrylate copolymer with pendent glycidyl groups. Indeed, applicant's assertion that this combination could potentially degrade other properties of the polymer is pure speculation since applicant has failed to provide any evidence or any teachings that the combination of teachings presented by the examiner would have any detrimental side effects.

6. Applicant's assertion on page 9 of the remarks that "Parekh suggest that the corrosion resistance properties are largely attributable to the primer layer" is not found persuasive. The coating disclosed of Parekh increases the corrosion resistance of the primer layer as well as being corrosion resistant by itself. (Col. 5, lines 25-27 "The present invention is directed to a coating composition that, after curing, effectively

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inhibits corrosion of metal substrates". The fact that the coating composition disclosed by Parekh has multiple benefits does not negate the combination made by the examiner.

/Rena L. Dye/  
Supervisory Patent Examiner, Art Unit 1782